REMARKS

In response to the Office Action dated September 2, 2004, Assignee respectfully requests reconsideration based on the above claim amendments and the following remarks. Assignee respectfully submits that the claims as presented are in condition for allowance.

The United States Patent and Trademark Office (the "Office") finally rejected claims 1-36 under 35 U.S.C. § 102 (e) as being anticipated by U. S. Patent 6,564,261 to Gudjonsson *et al.* The Office also rejected claims 21, 35, and 36 under 35 U.S.C. § 103 (a) as being unpatentable over *Gudjonsson.* The Assignee shows, however, that the amended claims are patentably distinguishable over *Gudjonsson,* and the Assignee thus respectively submits that the pending claims are ready for allowance.

Rejection of Claims 1-36 under 35 U.S.C. § 102 (e)

The Office rejected claims 1-36 under 35 U.S.C. § 102 (e) as being anticipated by U. S. Patent 6,564,261 to Gudjonsson *et al.* A claim is anticipated only if each and every element is found in a single prior art reference. *See Verdegaal Bros. v. Union Oil Co. of California,* 814 F.2d 628, 631, 2 U.S.P.Q. 2d (BNA) 1051, 1053 (Fed. Cir. 1987). *See also* DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2131 (orig. 8th Edition) (hereinafter "M.P.E.P."). As the Assignee shows, however, amended, independent claims 1, 12, and 24, and thus the dependent claims thereunder, are patentably distinguishable over *Gudjonsson.* The reference to *Gudjonsson* does not anticipate this invention, so the Assignee respectfully requests that Examiner Lezak remove the 35 U.S.C. § 102 (e) rejection of claims 1-36.

Independent claims 1, 12, and 24 have been amended to include features for providing graphical presentations. A graphical presentation is provided for each member's available contact devices. When a sender of a communication selects the graphical presentation, the

graphical prsentation initiates the communication with a chosen member. Amended claim 1 is reproduced below:

> 1. A method for identifying to a sender of a communication an availability of members through their contact devices, comprising:
>
> > storing a profile on each member, the profile identifying at least one contact device for each member;
> >
> > providing information on the profile for each member to the sender;
> >
> > tracking a communications presence of the contact device for each member, the tracking including determining the availability of the contact device for each member; and
> >
> > providing to the sender a graphical presentation for each member's available contact devices, and the graphical presentation, when selected by the sender, initiating the communication with a chosen member's available contact device.

Independent claims 12 and 24 have been amended to include similar features. Support for these features may be found at least at page 10, lines 4-16 of the application. FIG. 3 of the application also shows these graphical presentations for each member's available contact devices. As page 10 explains, when the graphical presentation is selected by the sender, a communication is initiated with the chosen member.

Gudjonsson does not anticipate independent claims 1, 12, and 24. *Gudjonsson* does not teach "providing to the sender a graphical presentation for each member's available contact devices, and the graphical presentation, when selected by the sender, initiating the communication with a chosen member's available contact device," as claims 1, 12, and 24 recite. As the Assignee has repeatedly emphasized, *Gudjonsson*, in contradistinction, utilizes a "routing service" that automatically establishes a "rendezvous" between users. *Gudjonsson* is entirely intelligent — the sender of a communication cannot select which available contact device is chosen. *Gudjonsson*, instead, uses software logic to determine where a communication is

delivered — the sender of the communication has no knowledge of another's available client devices.

Gudjonsson explains this "routing service." The "routing service for the receiving user determines, according to a logic specified by the same receiving user, how the request is handled and what services are available to handle the request." *See* U. S. Patent 6,564,261 to Gudjonsson *et al.* at column 3, lines 19-22. "[A] user may establish a communication session with another user *without knowledge of the client device ... being used by the other user; as the network arranges for communication ... between users regardless of the client device being used by the called user.*" *See id.* at column 3, lines 51-58 (emphasis added). *"Thus, the network enables any of the above communication services between users, and the initiating user need not know whether the other user is currently online via his/her PC or may instead be reached via pager or mobile phone."* *See id.* at column 3, lines 58-63 (emphasis added).

Gudjonsson continues explaining this "routing service." "In basic terms, aspects of the system/network act as broker(s), and can *broker communication services between two or more people."* *See Gudjonsson* at column 7, lines 52-54 (emphasis added). "When a user wishes to establish a communication with another user, he/she will invoke some function within his/her client, requesting the client to send an invitation of a given type to some selected user." *See id.* at column 9, lines 14-16. "The user's client will then form the correct SIP message and send it to a special service ... called the Routing Service (RS)." *See id.* at column 9, lines 17-20. *The "Routing Service (RS) of the called user (i.e. the callee) will decide how this invitation should be handled, without the calling user (i.e. caller) having to know how the communications channel between the users was set-up or on what network."* *See id.* at column 10, lines 33-37 (emphasis added). "The receiving RS decides what to do with the invitation according to user specified logic and available back-end services." *See id.* at column 13, lines 28-30.

Gudjonsson also provides an example. "[W]hen user A sends user B a message, as in FIG. 3, the following happens: 1) User A's client sends user A's routing service the message; 2) *User A's routing service ... runs it's "outgoing routing logic" ...;* 3) *User B's routing service receives the message ... and runs its "incoming routing logic."* *See Gudjonsson* at column 22,

lines 29-39 (emphasis added). "[B]oth the ougoing routing logic and the incoming routing logic can decide to forward the message ... , store the message ... , or deliver the message down to the user's client." *See id.* at column 22, lines 45-51. The routing logic can be based on "a number of parameters" and "profiles" defined by the client." *See id.* at column 23, lines 13-32.

Gudjonsson also discusses the advantages of this "routing service." "[R]outing services offer benefits both for the caller (invitor) and the callee (invitee)." *See Gudjonsson* at column 13, lines 46-48. *"For the caller it hides the messy details on how to locate and reach a given person/user at any given time."* *See Gudjonsson* at column 13, lines 49-50 (emphasis added).

Gudjonsson, then, does not anticipate independent claims 1, 12, and 24. *Gudjonsson*, as shown above, does not provide "to the sender a graphical presentation for each member's available contact devices, and the graphical presentation, when selected by the sender, initiating the communication with a chosen member's available contact device." *Gudjonsson*, in contradistinction, utilizes a "routing service" that determines where a communication is delivered — the sender has no knowledge of another's available client devices. Because *Gudjonsson* "hides the messy details" by not allowing the user to select which contact device is desired, *Gudjonsson* cannot anticipate independent claims 1, 12, and 24 of this invention. The Assignee, then, respectfully asks the Office to remove the § 102 rejection and to allow claims 1, 12, and 24.

The dependent claims are also not anticipated. Because *Gudjonsson* does not anticipate independent claims 1, 12, and 24, the dependent claims are likewise unanticipated. The Assignee, then, respectfully asks Examiner Lezak to remove the § 102 rejection of the dependent claims.

Rejection of Claims 21, 35, and 36 under 35 U.S.C. § 103 (a)

The Office also rejected claims 21, 35, and 36 under 35 U.S.C. § 103 (a) as being obvious over *Gudjonsson*. If the Office wishes to establish a *prima facie* case of obviousness, three criteria must be met: 1) combining prior art requires "some teaching, suggestion, or motivation to
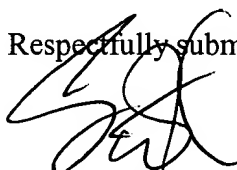
do so found either in the references themselves or in the knowledge generally available to one of ordinary skill"; 2) there must be a reasonable expectation of success; and 3) all the claimed limitations must be taught or suggested by the prior art. DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2143 (orig. 8th Edition) (hereinafter "M.P.E.P."). As this response explains above, *Gudjonsson* does not teach or suggest all the limitations of claims 21, 35, and 36.

Claims 21, 35, and 36 are not obvious in view of *Gudjonsson*. Claims 21, 35, and 36 are dependent claims and, thus, incorporate all the limitations of the respective independent claim. Independent claims 1, 12, and 24, as explained above, have been amended to recite features not taught by *Gudjonsson*. One of ordinary skill in the art, then, would not find it obvious to modify the teachings of *Gudjonsson* to obviate claims 1-36. Because *Gudjonsson* does not teach or suggest all the claimed features, the Assignee respectfully requests removal of the § 103 (a) rejection.

The reference to *Gudjonsson* does not anticipate the pending claims. The Office has also failed to establish a *prima facie* case for obviousness. Because the pending claims are patentably distinguishable over *Gudjonsson*, the Assignee respectively requests that a Notice of Allowability issue.

If any issues remain outstanding, the Office is requested to contact the undersigned at (919) 387-6907 or *scott@scottzimmerman.com*.

Respectfully submitted,

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